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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,891	01/25/2002	Naotaka Wachi	Q68255	5436
23373	7590	04/01/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			SCHILLING, RICHARD L	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,891

Applicant(s)

WACHI ET AL.

Examiner

Richard L Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-32, 34, 36 and 38-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 17-20, 22-32, 34, 36, 38-46 is/are rejected.
- 7) ☒ Claim(s) 7-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 1-6, 17-20, 22-32, 34, 36 and 38-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wachi et al. '504 or the combination of Japanese Publications 2001/310941 and 2001/328287 all further in view of Kawakami et al. for the same reasons as set forth in paragraph 1 of the third Office action filed September 10, 2003.

2. Claims 1-6, 17-20, 22-32, 34, 36 and 38-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wachi et al. '504 or the combination of Japanese Publications 2001/310941 and 2001/328287 all further in view of Kawakami et al. as set forth in paragraph 1 above further in view of Miyake et al. for the same reasons as set forth in paragraph 2 of the third Office action.

3. Claims 1-6, 17-20, 22-32, 34, 36 and 38-46 are rejected under 35 U.S.C. 102(e) as anticipated by Nakamura et al. '418 for the same reasons as set forth in paragraph 3 of the last office action.

4. Applicants' arguments filed March 10, 2004 have been fully considered but they are not deemed to be persuasive. Applicants' argument that Wachi et al. and the Japanese publications do not disclose laser outputs and scanning speed as required by instant claim 1 is unconvincing since instant claim 1 is directed to a material and not a process using a particular

laser and scanning speed. The intended use of the elements of the instant claims does not materially distinguish them over the applied prior art. The elements in Wachi et al. and the Japanese publications may inherently be used with lasers and scanning speeds as set forth in instant claim 1. The lasers in Wachi et al. used in Examples 1 and 2 have power levels as required by the instant claims and the scanning speeds in Wachi et al. are preferably over 3 meters per second which includes over 7 meters per second of instant claim 1. Example 2 in Wachi et al. has scanning speeds of 6 meters per second. Applicants' argument that Kawakami et al. does not teach light to heat conversion layers with matting agents with particle sizes as required by the instant claims is unconvincing since it is Wachi et al., the Japanese publications and Miyake et al. which are relied upon to disclose the use of matting agents having sizes as required by the instant claims in light to heat conversion layers. Applicants' argument that Miyake et al. does not disclose the lasers and scanning speeds required by the instant claims is unconvincing since Miyake et al. is not used to teach laser scanning speeds and the intended scanning speeds of the instant claims does not materially distinguish over the applied prior art. Applicants' argument that Nakamura et al. fails to teach the feature of a laser with the power and scanning speed of the

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instant claims is unconvincing since the intended use of the materials of the instant claims does not distinguish over the materials in Nakamura et al. Also, Nakamura et al. in paragraph 217 discloses scanning speeds preferably greater than 3 meters per second which includes 7 meters per second required by the instant claims. The lasers used in working Examples 1-2 and 2-1 have power levels as required by the instant claims. The scanning speed in working Example 2-1 of Nakamura et al. is over 9 meters per second which is within the range of over 7 meters per second recited in instant claim 1. Therefore, the elements in Nakamura et al. are capable of being used in processes using lasers and scanning speeds as recited in instant claim 1.

5. Claims 7-16 are objected to as depending on a rejected claim but would be allowable if written in proper independent form.

6. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS

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ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

March 25, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1100

